

REMARKS/ARGUMENTS

In the first office action, the examiner requires restriction to one of the following inventions under 35 U.S.C. §121:

Group I: Claims 3-57, drawn to an apparatus, classified in class 99, subclass 349.

Group II: Claims 58-81, drawn to a method for preparing pizza, classified in class 426, subclass 296.

The examiner requires election of one group for prosecution on the merits, even if restriction is traversed, in accordance with 37 C.F.R. §1.143.

After entry of this amendment, claims 1-84 are pending in the application. In this amendment, and in accordance with the election below, claims 57-83 are withdrawn, and claim 84 is added.

Election and Traversal

Applicant provisionally elects Group I (claims 3-57, drawn to an apparatus, classified in class 99, subclass 349) for immediate prosecution, and respectfully traverses the restriction requirement, requesting reconsideration and withdrawal of same.

Applicant makes no representation by this election regarding the possible existence of multiple independent and/or distinct inventions among the claims of record. Pursuant to 37 C.F.R. § 1.143, the request for reconsideration is made to preserve applicant's right of petition should the examiner reassert restriction.

Examiner's requirement of demonstrating extra burden on the PTO has not been satisfied

Even if two or more claim groupings are independent or distinct as claimed, there must also be a serious burden on the examiner to require restriction. M.P.E.P. §803. If the

search and examination of the an entire application can be made without serious burden, the examiner must examine the application on its merits, in its entirety, even though the application includes claims to distinct and/or independent inventions. M.P.E.P. §803. The examiner has failed to show that examining both groups on the merits would present a serious burden.

In examiner's paragraph 4, the examiner states, "the search required for Group I is not required for Group II." This statement is merely conclusory. The examiner does not claim that examination of either group requires search in a class or subclass having no art pertinent to the other group. Nor does the examiner indicate the purported different field of search. Even if the examiner indicated the different field of search, an explanation of how the different field of search was pertinent to the respective group, and only that group, is necessary.

Practical and equitable considerations mandate review of applicant's claims as a single application

A close examination of the practical and equitable considerations surrounding the present case compels withdrawal of the examiner's restriction requirement and requires inclusion of all the claims presented by applicant in a single patent application. The salient consideration for insisting upon restriction and determining the propriety of a restriction requirement is the scope of the examiner's search for prior art. Applicant is entitled to a full and thorough search of the prior art as a consequence of having filed his application and having paid the statutory application fee. 35 U.S.C. §131.

The examiner's instructional guidelines for performing such a search for any application are set forth in the M.P.E.P. The guidelines compel the examiner to search in

classes and subclasses in which independent and distinct inventions would be classified. For example, §904.01(c) recites:

Not only must the art be searched with which the invention claimed is classifiable, but also all analogous arts regardless of where classified. The determination of when arts are analogous is at times difficult. It depends upon the necessary essential function or utility of the subject matter covered by the claims, and not upon what it is called. (emphasis added).

MPEP §904.01(d) recites:

A proper field of search includes the subclass in which the claimed subject matter of an application would be properly classified.

In outlining a field of search the examiner should note every class and subclass under the U.S. Patent Classification system and other organized systems of literature, that may have material pertinent to the subject matter as claimed. Every subclass, digest and cross reference art collection pertinent to each type of invention claimed should be listed, from the largest combination through the various subcombinations to the most elementary part. **The search should extend to all probable areas relevant** to the claimed subject matter and should cover the disclosed features which might reasonably be expected to be claimed.

The examiner should plan a search that not only covers the claimed subject matter, but one that also covers the disclosed features that might reasonably be expected to be claimed.

MPEP §904.02 recites:

It is a prerequisite to a speedy and just determination of the issues involved in the examination of an application that a careful and comprehensive search, commensurate with the limitations appearing in the most detailed claims in the case, be made in preparing the first action on the merits so that the second action on the merits can be made final or the application allowed with no further searching other than to update the original search. It is normally not enough that references be selected to meet only the terms of the claims alone, especially if only broad claims are presented; but the search should, insofar as possible, also cover all subject matter which the examiner reasonably anticipates might be incorporated into applicant's amendment.

It thus results that the examiner finds references that, while not needed for treating the claims, would be useful for forestalling the possible presentation of claims to other subject matter regarded by applicant as his or her invention, and claimable with the subject matter being currently claimed, but shown to be old by these references.

From the above-quoted guidelines, it is clear that the scope of a proper search includes:

- (1) classes and subclasses in which the claimed subject matter is classified;
- (2) classes and subclasses that may have material pertinent to the claimed subject matter;
- (3) classes and subclasses containing subject matter present in the disclosure which might reasonably be expected to be claimed during the prosecution; and
- (4) classes and subclasses that may contain subject matter disclosing material related to features which might reasonably be expected to be claimed.

Examination of Groups I and II will require overlapping searches

Only where inventions are independent and distinct and require non-overlapping searches, is restriction proper. Art relevant to the Group II claims will overlap considerably with the art relevant to the Group I claims. To be sure, reference is made to a parent application, U.S. Application Serial No. 09/294,702, filed April 19, 1999 (now U.S. Patent No. 6,245,370), where references cited by the examiner include those classified in class 99, subclass 349; class 426, subclass 296; and others.

Thus, the examiner will not be unduly burdened by searching and examining all of the claims presented by applicant in a single application. The examiner's search will not be narrowed or reduced by compliance with the restriction requirement, since applicant has

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clearly manifested his intent to claim each novel and non-obvious aspect of the invention as evidenced by the claims in the application.

Linking Claim

Applicant notes that added claim 82 is a linking claim, as defined in M.P.E.P. § 806.05(e), and must be examined with the elected invention. If it is ultimately allowed, rejoinder is required. M.P.E.P. § 809.04.

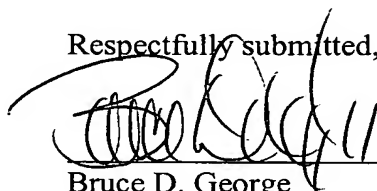
Conclusion

For the foregoing reasons, applicant respectfully requests reconsideration and withdraw of the restriction requirement. Notification that the restriction requirement has been reconsidered and withdrawn is respectfully solicited.

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Respectfully submitted,



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